

Application No. 10/710,039

REMARKS

Claims 1-17 and 22-25 are pending. By this Amendment, claims 18-21 are cancelled without prejudice, and claims 8, 17 and 25 are amended. No new matter is introduced by the present Amendment.

In the Office Action, the Examiner objected to the abstract because it is not limited to a single paragraph. Applicants note that the MPEP states that, "the abstract should be narrative in form and generally limited to a single paragraph within the range of 50 to 150 words." See MPEP § 608.01(b) (emphasis added). The MPEP does not require the abstract to be limited to a single paragraph, however, Applicants have condensed the abstract to a single paragraph in order to advance prosecution.

The Examiner also objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Applicants have amended the specification to provide proper antecedent basis for the claimed subject matter. Specifically, Applicants have amended the specification to provide proper antecedent basis for a belt and for an X group comprising a C_6H_3 group. The Examiner also objected to the un-capitalized use of the Trademark CALGON. Applicants have amended the specification to capitalize the trademark CALGON.

The Examiner objected to various portions of the specification, asserting that, "it is not clear how a methylene group, which is divalent, can be replaced with groups that are not divalent," and "it is not clear what is meant by the term part of a ring group." These issues are discussed below in the rejections under 35 U.S.C. § 112.

Restriction Requirement Under 35 U.S.C. § 121

The Examiner imposed a restriction requirement under 35 U.S.C. § 121, and indicated that restriction to one of the following inventions was required: Group I (claims 1-17 and 22-25); or Group II (claims 18-21). Applicants confirm without traverse the provisional election

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made during a telephone conference on February 28, 2005, to prosecute the invention of Group I, claims 1-17 and 22-25. Claims 18-21 have been cancelled without prejudice.

Claiming Benefit Of Earlier Filed Provisional Application Under 119(e)

The Examiner asserted that the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-17 and 22-25 of this application. However, it is well established that priority claims under sections 119 and 120 are evaluated on a claim by claim basis. The evaluation of the particular priority date of a claim need only be considered under circumstances in which there is an intervening reference with a critical date between the actual filing date and the date of a priority claim. This issue is moot until such a reference becomes of record. See, for example, the discussion in the context of a foreign priority claim under section 119 in MPEP 201.15. Therefore, Applicants do not presently consider this issue further.

Rejections Under 35 U.S.C. § 112 Second Paragraph

The Examiner rejected claims 1-17 and 22-25 under 35 U.S.C. § 112, second paragraph, as being indefinite. More specifically, with respect to claims 1, 9, and 22, the Examiner asserted that those claims are indefinite because "it is not clear what is meant by the term 'part of a ring group.'" "The test for definiteness under 35 U.S.C. 112, second paragraph, is whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification.'" See MPEP § 2173.02 (quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081, 1088 (Fed.Cir 1986)). Applicants submit that one of ordinary skill in the art would understand that term "part of a ring group" refers to an atom or group that is bonded to

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other atoms or groups that form a ring system. For example, a carbon atom in a benzyl group is a part of a ring group. Thus, claims 1, 9 and 22 are clearly indicating that R_1 , R_2 , R_3 , R_4 can be or atoms or groups that are bonded into ring systems. Particularly, for example, this terminology allows for R_1 and R_2 , as well as R_3 and R_4 , to jointly form a ring group. Since one of ordinary skill in the art would understand the scope of the term "part of a ring group," claims 1, 9 and 22 are definite.

The Examiner also asserted that claims 8, 17 and 25 are indefinite because "it is not clear how a methylene group, which is divalent, can be replaced with groups that are not divalent." As discussed above, "the test for definiteness under 35 U.S.C. 112, second paragraph, is whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification.'" See MPEP § 2173.02. Applicants submit that claims 8, 17 and 25 clearly indicate that one or more of the methylene groups can be replaced by O, S, N, C, B, F, C=O, O=S=O, a heterocyclic group, an aromatic group, urethane, urea, an ester group, an NR_6 group, a CR_7 , or a CR_8R_9 group. One of ordinary skill in the art would recognize that the substituted groups would be inserted in the methylene chain in such a way as to provide the appropriate number of bonds to each group. Thus, as long as the group is at least double valent, the remaining portions of the group can be appropriately substituted based on the liberal substitution defined in the specification. For example, two adjacent methylene groups can be replaced by a nitrogen atom double bonded to a carbon atom. Since one of ordinary skill in the art would understand the scope of claims 8, 17, and 25, claims 8, 17 and 25 are definite.

The Examiner also asserted that claims 8, 17 and 25 are indefinite because "it is not clear to what the R groups in the groups are bonded." Applicants have deleted "the bond" language

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from claims 8, 17 and 25, and as such the Examiner's rejection of claims 8, 17 and 25 is presently moot.

The Examiner also asserted that claims 8, 17 and 25 are indefinite because "it is not clear what is meant by the term 'part of a ring group.'" As discussed above, Applicants submit that one of ordinary skill in the art would understand what term "part of a ring groups" means, and thus claims 8, 17 and 25 are definite.

Since claims 1-17 and 22-25 are definite, Applicants respectfully request the withdrawal of the rejections of claims 1-17 and 22-25 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Rejections Under 35 U.S.C. § 103

The Examiner provisionally rejected claims 1-17 and 22-25 under 35 U.S.C. § 103(a) as being obvious over co-pending Application No. 10/663,971. "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section, where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. § 103(c). Applicants submit that, at the time of the invention of the present application, the present application and the '971 application were subject to an obligation of assignment to the same person. As such, the '971 Application is not a proper prior art reference under 35 U.S.C. § 103(c). Applicants respectfully request withdrawal of the rejection of claims 1-17 and 22-25 under 35 U.S.C. § 103(a) as being obvious over co-pending Application No. 10/663,971.

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Double Patenting Rejection

The Examiner provisionally rejected claims 1-6, 8-14, 16, 17 and 22-25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of co-pending Application No. 10/663,971 (the '971 Application). Additionally, the Examiner provisionally rejected claims 7 and 15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of the '971 Application in view of Diamond, Handbook of Imaging Materials, pp. 395-396. Applicants submit that the Examiner has not established a prima facie case of obviousness and that the invention of the '971 Application and the invention of present application are patentably distinct. Applicants respectfully request reconsideration of the rejection in view of the following comments.

In order to establish a prima facie case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP § 2143. Applicants' invention, as claimed in independent claims 1, 9, 18 and 22, relates to a charge transport compound having an X and X' group bonded to an NR₁R₂ and NR₃R₄ group, respectively, wherein the X group comprises an aromatic group. In contrast, the '971 Application does not disclose or suggest an aromatic X and X' group bonded to an NR₁R₂ and NR₃R₄ group, respectively. Since the '971 Application does not disclose or suggest an aromatic X and X' group bonded to an amine group, the '971 Application does not disclose or suggest all of the features of Applicants' claimed invention, and thus does not render Applicants' claimed invention prima facie obvious.

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Since the '971 Application does not render Applicants' invention, as claimed in independent claims 1, 9, 18 and 22, prima facie obvious, Applicants' respectfully request the withdrawal of the rejection under the judicially created doctrine of obviousness-type double patenting.

With respect to rejections of claims 7 and 15, claim 7 depends from claim 1 and claim 15 depends from claim 9. As such, claims 7 and 15 incorporate all of the features of claims 1 and 9, respectively. As discussed above, the '971 Application does not render claims 1 and 9 prima facie obvious. Additionally, the disclosure of the Handbook of Imaging Materials does not render claims 1 and 9 prima facie obvious. As such, the combination of the '971 Application and the Handbook of Imaging Materials does not render claims 1 and 9 prima facie obvious. Since the combination of the '971 Application and the Handbook of Imaging Materials does not render claims 1 and 9 prima facie obvious, Applicant's respectfully request the withdrawal of the rejection of claims 7 and 15 under the judicially created doctrine of obvious type double patenting.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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